

## **REMARKS**

### I. General Remarks

In the specification, line 21 of page 21, line 20 of page 22 and line 8 of page 29 are amended so that to capitalize trademark AMERICAN TYPE CULTURE COLLECTION. In the specification, line 18 of page 20, line 24 of page 23 and line 2 of page 26 are amended to capitalize trademark COULTER. In the specification, line 25 of page 26, line 22 of page 29 and lines 24 and 26 of page 31 are amended so that to capitalize trademark AMERSHAM. In the specification, lines 2 and 8 of page 28, lines 7, 13, 15 and 23 of page 30, lines 7 and 9 of page 31 are amended so that to capitalize trademark PROMEGA.

In claims, claims 95 and 101 are amended to correct obvious typographical errors.

### II. Patentability Arguments

#### A. The Objections Should Be Withdrawn

Claim 2 was objected to by the Examiner because it was dependent from rejected claim 1. However, claim 1 has been amended and the applicants believe that it is allowable. Therefore, the applicants request withdrawal of objection to claim 2.

Claim 16 was objected to by the Examiner as being dependent upon claim 14, which was rejected under the judicially created doctrine of obviousness-type double patenting. This objection is rendered moot in view of the terminal disclaimer filed herewith and therefore, the objection should be withdrawn.

The objection to claim 96 is moot because the claim has been cancelled.

#### B. The Rejections Under 35 U.S.C. §112, First Paragraph, Should Be Withdrawn

The Examiner rejected claims 63, 64, 108 and 109 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The rejection is moot because claims 63, 64, 108 and 109 have been cancelled.

At page 4 of the Office action, the Examiner rejected claims 1, 3, 4, 5, 6, 85, 88 and 89 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement because “the claims encompass RNA oligonucleotides.” However, at page 7 of the Office action, the Examiner states:

“The specification provides sufficient guidance for using a DNA oligonucleotide, wherein said deoxynucleotide is approximately 2-200 nucleotides in length, and wherein the DNA oligonucleotide comprises a phosphodiester backbone in the claimed methods. However, the breadth of the claims read on using any type of oligonucleotide (DNA, RNA, etc) and the specification does not provide sufficient guidance for using any RNA oligonucleotide in the claimed methods.”

In response, claims 1, 3, 4, 5, 6, 88 and 89 have been amended herein to specifically recite a DNA oligonucleotide. In view of the above amendment, applicants submit that the rejection of claims 1, 3, 4, 5, 6, 85, 88, and 89 under 35 U.S.C. § 112, first paragraph, should be withdrawn and withdrawal is requested.

**B. The Rejections Under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn**

Dependent claims 77-79 and 81 stand rejected under 35 U.S.C. § 112, second paragraph. At page 9 of the Office Action, the Examiner alleges that there is insufficient antecedent basis for the “DNA fragment” limitation in the claims. In response, applicants have amended claims 77-79 and 81 herein to delete the “DNA fragment” limitation and to recite “a composition” according to allowed claim 75 from which the claims depend. Specifically, amended claims 77-79 and 81 recite a limitation to “a composition comprising at least one DNA oligonucleotide comprising a phosphodiester backbone, wherein the oligonucleotide has a nucleotide sequence consisting of SEQ ID No: 1, SEQ ID No: 6 or pTpT.”

Applicants respectfully submit that amended claims 77-79 and 81 meet the requirements of 35 U.S.C. § 112, second paragraph and therefore, the rejections under 35 U.S.C. § 112, second paragraph, should be reconsidered and withdrawn.

**C. The Double Patenting Rejection Should Be Withdrawn**

Claims 1, 3, 5, 6, 8, 14, 15, 17, 19 and 93 of the instant application have been rejected over claims 1-8, 12-18 and 22 of co-owned U.S. Patent 5,643,556 under the judicially created doctrine of obviousness-type double patenting.

The Examiner has also rejected claims 1, 3, 6, 14, 15, 19 and 93 of the instant application over claims 1-4, 6 and 8 of co-owned U.S. Patent 5,532,001 under the judicially created doctrine of obviousness-type double patenting.

The Examiner rejected claims 8, 14, 15, 19 and 93 of the instant application over claims 1-6 and 8 of co-owned U.S. Patent 5,580,547 under the judicially created doctrine of obviousness-type double patenting.

The Examiner rejected claims 14, 15, 19 and 93 of the instant application over claims 1, 2, 3, 4, 6 and 8 of co-owned U.S. Patent 5,470,577 under the judicially created doctrine of obviousness-type double patenting.

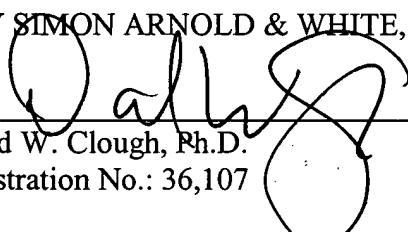
In response, applicants file herewith four terminal disclaimers in compliance with 37 CFR 1.321(c) to obviate each of the four obviousness-type double patenting rejections and therefore the rejections should be withdrawn.

### **Conclusion**

Applicants respectfully submit that the claims are in condition for allowance and early notification thereof is requested. If in the interest of expediting prosecution, the Examiner has questions or comments he is invited to telephone the undersigned at the indicated telephone number.

Respectfully submitted,

HOWREY SIMON ARNOLD & WHITE, LLP

By: 

David W. Clough, Ph.D.  
Registration No.: 36,107

Dated: December 10, 2003  
321 N. Clark Street, Suite 3400  
Chicago, IL 60610  
Telephone: (312) 595-1408  
Fax: (312) 595-2250